

REMARKS

Reconsideration and withdrawal of the rejections made in the present Office Action are respectfully requested, in view of the following remarks.

Summary of Office Action

Applicants note with appreciation that the rejections in the previous Office Action of claims 31-61 under 35 U.S.C. § 102(e) over Ognyanov et al., U.S. Patent No. 6,191,165, and under 35 U.S.C. § 112, second paragraph, are withdrawn.

Claims 31-61 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bondinell et al., U.S. Patent No. 4,514,414 (hereafter "BONDINELL") in view of Sonnewald, U.S. Patent No. 4,931,450 (hereafter "SONNEWALD") and Ali et al., CAPLUS data base No. 102: 160041 (hereafter "ALI").

Response to Rejection

In the present Office Action, claims 31-61, i.e., all pending claims, are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over BONDINELL in view of SONNEWALD and ALI. In this regard, the examiner essentially argues that BONDINELL discloses compounds which are structurally similar to some of the claimed compounds, the

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difference between these compounds being in the position of the substituent on the pyrrolidine ring, i.e., 2-position in the case of the claimed compounds, and 3-position in the case of the compounds of the reference. Furthermore, the Examiner appears to allege that the two remaining cited documents, i.e., SONNEWALD and ALI, teach that, in compounds homologous to those disclosed in BONDINELL, there is no difference in biological activity between 2-substitution and 3-substitution, wherefore a person of ordinary skill in the art would allegedly have expected that compounds which differ from those of BONDINELL with respect to the position of the substituent (2- vs. 3-), i.e., compounds of the present invention, would have a GABA inhibiting activity similar to that of the BONDINELL compounds. This rejection is respectfully traversed for at least the following reasons.

Applicants do not find any disclosure in SONNEWALD and ALI which could support the Examiner's allegation with respect to a similar activity of 2- and 3-substituted compounds of the type claimed in the instant application. Applicants note that the rejection does not indicate the specific passages of SONNEWALD and ALI on which the Examiner's allegations are based, wherefore Applicants do not know to which specific passages of SONNEWALD and ALI the Examiner is referring. In view thereof, should the following arguments with respect to SONNEWALD and ALI not be found convincing because they do not address the specific passages of these two documents which the Examiner has in mind, Applicants respectfully request that they be given the opportunity to present their arguments

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in response to a further non-final Office Action wherein the Examiner explains with specificity why the disclosures of SONNEWALD and ALI are allegedly relevant in the present context so that Applicants are afforded a full and fair opportunity to respond.

Regarding ALI, it appears that this document does not specifically refer to compounds having a 2-substituted pyrrolidine ring. For example, the compound of formula I as depicted in ALI is a 3-substituted piperidinecarboxylic acid. While ALI makes reference also to “pyrrolidineacetic acids”, this document does not indicate at which position the pyrrolidine ring structure of these compounds is substituted by the carboxymethyl group (2- or 3-position).

With respect to SONNEWALD, it is noted that the 3-butenyl compounds of formula (I) as depicted in, e.g., column 1 and claim 1 of SONNEWALD do not have any 2-substituted nitrogen-containing ring as group R³. In particular, R³ in said formula (I) is 3-carboxypiperid-1-yl, 3-carboxy-1,2,5,6-tetrahydropyrid-1-yl or 3-carboxymethylpyrrolidin-1-yl, or the corresponding amide, lower alkyl ester or salt group (e.g., col. 1, lines 29-32).

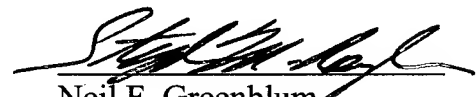
In view of the foregoing, and contrary to what is alleged by the examiner, one of ordinary skill in the art would not have been motivated by SONNEWALD and ALI to modify the 3-substituted compounds disclosed in BONDINELL by moving the 3-substituent on the pyrrolidine ring thereof to the 2-position. Therefore, the rejection under 35 U.S.C. § 103(a) is not justified and withdrawal thereof is respectfully requested.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested.

If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the number given below.

Respectfully submitted,
K. WANNER et al.


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Reg. No. 28,394 *Reg. No.*
31,296

November 12, 2002
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